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Eng Sia Lee

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EXAMINER

BATISTA, MARCOS

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

07/24/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

Art Unit- Location

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Arguments

Applicant's arguments filed on 06/06/2008 have been fully considered but they are not persuasive.

After carefully revising the office action pertinent to the present response and remarks, 2 main points have been identified: **1)** the applicant states that reference “Deeds (US 20040203610 A1),” does not qualify as prior art because the publication date (10/14/2004) is after the invention’s priority date, which claims priority of a PCT filed on 10/13/2004 (refer to page 1, fourth paragraph of the applicant's remarks); **2)** the applicant states that reference “Valloppillil et al. (US 20040137921 A1),” does not qualify as prior art because the publication date (07/15/2004) is after the invention’s foreign priority date, which claims foreign priority to Malaysia application “PI 20033905” filed on 10/14/2003 (refer to page 2, second paragraph of the applicant's remarks).

Regarding point **1)**, reference “Deeds (US 20040203610 A1),” has been used in a 103(a) rejection relying on the filing date (04/25/2002), which qualifies as prior art over the application’s priority date (10/13/2004) and foreign priory date (10/14/2003), (see

session 5 below and MPEP 706.02, 2126, and 2136)

Regarding point 2), reference “Valloppillil et al. (US 20040137921 A1),” has been used in a 103(a) rejection relying on the filing date (10/02/2003), which qualifies as prior art over the application’s priority date (10/13/2004) and foreign priority date (10/14/2003), (see session 9 below MPEP 706.02, 2126, and 2136).

Therefore, since the argued points do not overcome the rejection, the application remains rejected based on the previous rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 4-7, 9-17, 19, 20, 22-25, 27-35, 37, 39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Deeds (US 20040203610 A1), hereafter "Deeds."

Consider claim 1, Dowden discloses a messaging-enabled communications device configured for a roaming-free connection to a mobile telephone services provider (see abstract, Fig 6, col. 1 lines 3-14, col. 15 lines 3-11). Dowden also teaches a gateway being for placing a telephone call to a destination telephone having a telephone number indicated by a message received from the mobile communications device and also for placing a telephone call to the user though the service provider to patch the user to the destination telephone without incurring roaming charges (see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13).

Dowden discloses an SMS callback system where a message is sent to an SMS server, which then relates that information to a gateway. The gateway that connects the called and the calling parties, regardless of their respective locations, as instructed by the SMS, thus eliminating the roaming charges. Dowden, however does not particular refer to a distributor, the distributor providing the communications device to a user or a communication device is registered with the gateway before it is provided to the user.

Chow teaches a distributor, the distributor providing the communications device to a user (see [0180] – where an electronics store provides a subscriber with a new phone). Chow also teaches a communication device is registered with the gateway before it is provided to the user (see [0180] – where a phone is registered by a salesperson upon acquiring it).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden and have it include distributor, the distributor providing the communications device to a user and a communication device is registered with the gateway before it is provided to the user, as taught by Chow. The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Dowden, as modified by Chow teaches the above mentioned feature of claim 1. Dowden, however, does not particular refer to wherein the communication device activates a ring-tone when the message is being received by the gateway.

Deeds teaches the communication device activates a ring-tone when the message is being received by the gateway (see [0035], [0037]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and have it include the communication device activates a ring-tone when the message is being received by the gateway, as taught by Deeds. The motivation would have been in order to notify the user of a particular event (see [0035], [0037]).

Consider claim 2, Dowden as modified by Chow and Deeds and Deeds teaches claim 1 above. Dowden also teaches wherein the message is an SMS (see col. 14 lines 20-21).

Consider claim 4, Dowden as modified by Chow and Deeds and Deeds teaches claim 1 above. Dowden also teaches wherein the mobile communications device is a mobile telephone (see fig. 6, #8a, col. 15 lines 3-6).

Consider claim 5, Dowden as modified by Chow and Deeds and Deeds teaches claim 1 above. Dowden also teaches wherein mobile communications device is a SIM card (see col. 6 lines 16-18, col. 12 lines 4-6).

Consider claim 6, Dowden as modified by Chow and Deeds and Deeds teaches claims 1 above. Dowden also teaches wherein the user receives the telephone call at the mobile communications device (see fig 5, col. 14 lines 4-5).

Consider claim 7, Dowden as modified by Chow and Deeds and Deeds teaches claims 1 above. Dowden also teaches wherein the user receives the telephone call at a telephone having a telephone number indicated by the message (see fig 6, col.16 lines 11-23).

Consider claim 9, Dowden as modified by Chow and Deeds and Deeds teaches claim 1 above. Chow also teaches wherein the mobile communications device is provided to the user by selling it to the user (see [0180]). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Consider claim 10, Dowden as modified by Chow and Deeds teaches claim 1 above. Chow also teaches wherein the distributor is a retail outlet (see [0180]). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Consider claim 11, Dowden as modified by Chow and Deeds teaches claim 1 above.

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Dowden also teaches wherein the distributor provides a selection of mobile communications devices configured for roaming free connections to different mobile telephone services providers (see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13 –where Dowden teaches a gateway that connects the called and the calling parties, regardless of their respective locations, as instructed by the SMS, thus eliminating the roaming charges).

Consider claim 12, Dowden as modified by Chow and Deeds teaches claim 1 above.

Dowden also teaches a database containing user identification information and billing information of the user (see fig 2 #77, col. 8 lines 3-18). Dowden also teaches an identification system for obtaining the user identification information from the message (see fig 3, col. 8 lines 16-17). Dowden further teaches a data processing system for matching the user identification information obtained from the message with the user identification information in the database to identify the user (see fig 2, fig 3, col. 8 lines 3-18).

Consider claim 13, Dowden as modified by Chow and Deeds teaches claim 1 above.

Chow also teaches wherein the user identification information and billing information of the user is entered into the database based on information obtained upon the user registering with the distributor (see [0180] – where Chow teaches registering a phone with a server provider. The registration of a phone is known in the art to include the billing information of the customer). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Consider claim 14, Dowden as modified by Chow and Deeds teaches claim 1 above.

Dowden also teaches wherein the user may enable a diversion of calls from another communication device to the gateway, whereby the calls may be connected to the messaging-

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enabled communications device (see col. 9 lines 3-9 – where Dowden teaches that the SNCP receives various service requests from the user).

Consider claim 15, Dowden as modified by Chow and Deeds teaches claim 1 above. Dowden also teaches wherein the distributor is located outside the service area of the mobile telephone services provider (see fig 5, col. 6 lines 7-18).

Consider claim 16, Dowden as modified by Chow and Deeds teaches claims 1 and 19 above. Dowden also teaches wherein the gateway is located outside the service area of the mobile telephone services provider (see fig 5, col. 6 lines 7-18).

Consider claim 17, Dowden as modified by Chow and Deeds teaches claims 1 and 19 above. Dowden also teaches wherein the gateway is arranged, upon receiving a first phone call from the communication device, to place a second phone call to the device and thereby initiate the sending of the message as part of the second phone call (see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13).

Consider claims 19, 20, 22-25, 27-35, these are method claims corresponding to system claims 1, 2, 4-7 and 9-17. Therefore, they have been analyzed and rejected based upon the system claims 1, 2, 4-7 and 9-17 respectively.

Consider claim 37, Dowden discloses messaging-enabled enabled phone arranged to generate a menu of options, the menu comprising destination telephone numbers (see col. 3 lines 21-22, col. 4 lines 4-5, col. 12 lines 1-11). Dowden also teaches wherein selection of one or more of the destination numbers causing the phone to generate a message to a service provider of SMS Callback (see col. 12 lines 1-18). Dowden also teaches the message containing indications of the at least one of the destination numbers (see col. 12 lines 1-18, col. 13 lines 10-19). Dowden

further teaches the message causing the service provider to place call(s) to the at least one destination number and also to place a call to the sender of the message, and patching the calls when they are connected (see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13). Chow also teaches a communication device is registered with the gateway before it is provided to the user (see [0180] – where a phone is registered by a salesperson upon acquiring it). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Dowden, as modified by Chow teaches the above mentioned feature of claim 37.

Dowden, however, does not particular refer to wherein the phone activates a ring-tone when the message is being received by the gateway.

Deeds teaches wherein the phone activates a ring-tone when the message is being received by the gateway (see [0035], [0037]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and have it include wherein the phone activates a ring-tone when the message is being received by the gateway, as taught by Deeds. The motivation would have been in order to notify the user of a particular event (see [0035], [0037]).

Consider claim 39, Dowden as modified by Chow and Deeds teaches claim 37 above.

Dowden also teaches wherein the message is an SMS (see col. 14 lines 20-21).

Consider claim 41, Dowden as modified by Chow and Deeds teaches claim 37 above. But Dowden does not particular refer to wherein the message masks the gateway of the service provider. Deeds teaches wherein the message masks the gateway of the service provider (see

[0058]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden and have it include wherein the message masks the gateway of the service provider, as taught by Deeds. The motivation would have been in order to prevent other users from identifying the communication device (see [0058]).

6. Claims 3, 21, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Deeds (US 20040203610 A1), hereafter "Deeds," further in view of Valloppillil et al. (US 20040137921 A1), hereafter "Valloppillil."

Consider claim 3, Dowden as modified by Chow and Deeds teaches claims 1 and 19 above. But Dowden does not particular refer to the message is an MMS. Valloppillil teaches wherein the message is an MMS (see fig 2A, [0040]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and Deeds and have it include the message is an MMS, as taught by Valloppillil. The motivation would have been in order to provide a message-enabled communication method between a mobile device and an SMS server (see fig 2A, [0040]).

Consider claim 21, this is a method claim corresponding to system claim 3. Therefore, it has been analyzed and rejected based upon the system claim 3 above.

Consider claim 38, Dowden as modified by Chow and Deeds teaches claim 37 above. But Dowden does not particular refer to message which is called up by a button in the messaging-

enabled phone. Valloppillil teaches message which is called up by a button in the messaging-enabled phone (see fig 3, [0113]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and Deeds and have it include message which is called up by a button in the messaging-enabled phone, as taught by Valloppillil. The motivation would have been in order to aid the user in composing messages (see fig 3, [0113]).

Consider claim 40, Dowden as modified by Chow and Deeds teaches claim 37 above. But Dowden does not particular refer to wherein the message is an MMS. Valloppillil teaches wherein the message is an MMS (see fig 2A, [0040]). The motivation would have been in order to provide a message-enabled communication method between a mobile device and an SMS server (see fig 2A, [0040]).

7. Claims 8 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Deeds (US 20040203610 A1), hereafter "Deeds," and further in view of Wittstein et al. (US 5631947 A), hereafter "Wittstein."

Consider claim 8, Dowden as modified by Chow and Deeds teaches claims 1 and 19 above. But Dowden does not particular refer to the mobile communications device is provided to the user by renting it to the user. Wittstein et teaches the mobile communications device is provided to the user by renting it to the user (see abstract, col. 12 lines 20-28).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the invention of Dowden as modified by Chow and Deeds and have it include the mobile communications device is provided to the user by renting it to the user, as taught by Wittsteinet. The motivation would have been in order to provide a user with a method for acquiring a communication device (see abstract, col. 12 lines 20-28).

Consider claim 26, this is a method claim corresponding to system claim 8. Therefore, it has been analyzed and rejected based upon the system claim 8 above.

9. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable Chow et al. (US 20030185203 A1), hereafter “Chow,” in view of Valloppillil et al. (US 20040137921 A1), hereafter “Valloppillil.”

Consider claim 42, Chow teaches the messaging-enabled enabled phone is registered with a gateway before it is provided to the user (see [0180] – where a phone is registered by a salesperson upon acquiring it).

Chow teaches claim 42 above, but does not particular refer to a button wherein a message is sent to a service provider providing SMS Callback when pressed. Valloppillil teaches message which is called up by a button in the messaging-enabled phone (see fig 3, [0113]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Chow and have it include message which is called up by a button in the messaging-enabled phone, as taught by Valloppillil. The motivation would have been in order to aid the user in composing and sending the messages to the SMS server (see fig 3, [0113]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marcos Batista, whose telephone number is (571) 270-5209. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached at (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Marcos Batista

/M. B./

07/15/2008

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617